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10/591,997	09/07/2006	Akira Motonaga	295767US0PCT	6778
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
PAUL, JESSICA MARIE				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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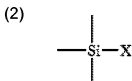
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## DETAILED ACTION

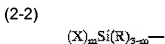
### *Response to Arguments*

Applicant's arguments filed 7/6/09 have been fully considered but they are not persuasive.

Applicants argue that octamethoxytrisiloxane, which applicants consider not a low molecular weight compound, if subjected in a photoreaction, will not itself not react. Takahashi et al. disclose a hydrolyzable metal compound (A), represented by the following formula (2):



Wherein X is a hydrolyzable functional group or ligand [0060]. A compound represented by the above mentioned formula (2), may include for example, a compound (A1), a compound (A2), and a compound (A3) having at least one or more molecular skeleton represented by the following general formula (2-2) [0064]:



Wherein m is an integer of 1, 2 or 3; R is a hydrocarbon group; and X is a hydrolyzable functional group [0066]. A specific example of compound (A3), which is considered by Takahashi et al. as a low molecular weight compound, is octamethoxytrisiloxane [0076] (reads on applicants required general formula 1). Takahashi et al. discloses an organometal compound (E) which promotes hydrolysis and condensation reaction of the

hydrolyzable metal compound (A). Takahashi et al. teaches an example comprising compounds (A), as taught above; compound (B), maleic anhydride; compound (C), a photoinitiator; compound (F), a compound having a cationic polymerizable group; and compound (E), hydrolysis and condensation catalyst [0222-0229, t6]. Takahashi et al. teaches when compound (F) is employed in the invention, it is preferable to include a compound which polymerizes or crosslinks the compound (F) (cationic polymerization initiator) [0146-0147]. Although Takahashi et al. do not explicitly disclose using octamethoxytrisiloxane in a preferred embodiment as compound (A), it is taught to be used as hydrolyzable metal compound (A) in the disclosure of the specification [0076]. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including the non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.). Therefore, it would have been obvious, to one having ordinary skill in the art, at the time of the invention, to try; picking and choosing from a finite number of identified, predictable solutions, with reasonable expectation of success.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the organometal compound (E) is added to promote a polymerization or crosslinking reaction of the hydrolyzable metal compound (A) after irradiation of light; not before irradiation of light, or when it is stored; and the chemical structure of siloxane compound (A)) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Takahashi et al. discloses the example as discussed above, comprising compounds (A) through (E) [0222-0229, t6]; and which may further comprise a cationic polymerization initiator [0146-0147]. Although Takahashi et al. does not explicitly disclose hydrolyzing and condensing the octamethoxytrisiloxane followed by adding the cationic polymerization initiator, in two separate steps; the examiner takes the position that the composition of the compound (A) is hydrolyzed and condensed in the presence of compound (E); and therefore the siloxane compound produced by the hydrolysis and condensation reaction of octamethoxytrisiloxane is then "added" to or in the presence of, the cationic polymerization initiator; which therefore reads on applicants' method for preparing a coating composition.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Paul whose telephone number is (571)270-5453. The examiner can normally be reached on Monday thru Friday 8:00- 6:00p; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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